

## REMARKS

This Response is submitted in reply to the Non-Final Office Action mailed on April 14, 2009. Claims 1, 2, 4, and 6 to 19 are pending in this application. Claims 3 and 5 stand previously cancelled. The Director is authorized to charge Deposit Account No. 02-1818 for any fees due in connection with this Response. If such a withdrawal is made, please indicate the Attorney Docket No. 0112857-00543 on the account statement.

### **Claim Rejections Under 35 U.S.C. § 103**

The Office Action rejected Claims 1, 12, 13, 16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent Application Publication No. 2002324381 to Ito (“Ito”) in view of Japanese Patent Application Publication No. 2001176189 to Osawa (“Osawa”). Applicant respectfully disagrees with, and traverses, this rejection.

Independent Claim 1 is directed to a recording medium managing apparatus which includes: “identification information supplying means for supplying identification information... wherein the identification information supplying means includes character string inputting means for inputting arbitrary character strings, and at least part of the identification information includes an arbitrary character string input by the character string inputting means.”

Pages 3 and 4 of the Office Action rely on Osawa for disclosure of “at least part of the identification information includes an arbitrary character string input by the character string inputting means...” The Office Action relies on the Abstract of Osawa, stating that the “random number generator [of Osawa] is [the] same as [an] arbitrary character string...” Accordingly, the Office Action appears to interpret a random number generated by the random number generator of Osawa to be the arbitrary character string of Claim 1. Applicant respectfully disagrees.

Section 2106 of the MPEP states:

[w]here means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the specification and “equivalents thereof” that correspond to the recited function. Two *en banc* decisions of the Federal Circuit have made clear that the USPTO is to interpret means plus function language according to 35 U.S.C. § 112, sixth paragraph. *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (*en banc*); *In re Alappat*, 33 F.3d 1526, 1540, 31 USPQ2d 1545, 1554 (Fed. Cir. 1994) (*en banc*).

Section 2181 of the MPEP states that:

A claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis: (A) the claim limitations must use the phrase “means for” or “step for;” (B) the “means for” or “step for” must be modified by functional language; and (C) the phrase “means for” or “step for” must not be modified by sufficient structure, material, or acts for achieving the specified function.

Applicant submits that the claimed limitation “character string inputting means for inputting arbitrary character strings” invokes 35 U.S.C. §112, sixth paragraph because: (A) it includes the phrase “means for;” (B) it is modified by the functional language “inputting arbitrary character strings;” and (C) it is not modified by additional structure for achieving the stated function.

Accordingly, because this limitation invokes 35 U.S.C. § 112, sixth paragraph interpretation, “the language must be interpreted to read on only the structures or materials disclosed in the specification and ‘equivalents thereof’ that correspond to the recited function.” (MPEP, § 2106). In this case, paragraph [0064] of the Specification states that “[t]he disk name 424 is an arbitrary character string input by the instruction input unit 192.” (Emphasis added). Paragraph [0054] states: “[t]he instruction input unit 192 is used by the user to input an instruction and, for example, is a keyboard or a button.” (Emphasis added). Therefore, Applicant submits that the claimed “character string inputting means for inputting arbitrary character strings” should be interpreted to read on a keyboard or a button and equivalents thereof that correspond to inputting arbitrary character strings.

Applicant submits that the random number generated by Osawa does not disclose or suggest a “character string inputting means for inputting arbitrary character strings” as claimed in independent Claim 1 and supported in the Specification of the present application. For example, the Abstract of Osawa discloses that “a control circuit 2 controls so as to write a random number generated in a random number generation circuit 10 on the optical disk 7...” The random number of Osawa is generated by a random number generation circuit under control of a control circuit. Therefore, the random number is not input by the user as is disclosed in the specification of the present applicant. Furthermore, the random number generation circuit of Osawa is not a keyboard or a button and equivalents thereof that correspond to inputting arbitrary character strings. Therefore, unlike the recording medium managing apparatus of independent Claim 1, Osawa does not disclose or suggest a “character string inputting means for

inputting arbitrary character strings” as claimed in independent Claim 1 and supported in the Specification of the present application. Ito fails to cure the deficiencies of Osawa. Moreover, it would not have been obvious to one having ordinary skill in the art to have modified Ito in view of Osawa to arrive at such a recording medium managing apparatus without reasonably being construed as impermissible hindsight reconstruction.

For at least these reasons, independent Claim 1 is patentably distinguished over these references and is in condition for allowance.

Independent Claims 12, 13, 16, and 17 include certain similar elements as independent Claim 1 and are allowable for similar reasons, and because of the additional features recited in these claims.

The Office Action rejected Claims 2, 4, 6 to 11, 14, 15, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Ito and Osawa, and further in view of U.S. Patent Application Publication No. 2002/0097645 to Mikawa (“Mikawa”). Applicant respectfully disagrees with, and traverses, this rejection.

As stated above with respect to independent Claim 1, Ito and Osawa fail to disclose or suggest a “character string inputting means for inputting arbitrary character strings” as claimed in independent Claim 1 and supported in the Specification of the present application. Mikawa fails to cure the deficiencies of Ito and Osawa.

Similarly to Osawa, paragraph [0041] of Mikawa discloses “[t]he identification information generator 115 uses the time and date information transmitted from the internal clock 119 and an ID, a random number and the like which are unique to the read/write apparatus 100, so as to create the content identification information that is unique data.” That is, the identification information of Mikawa includes only a randomly generated number. Nothing in Mikawa discloses or suggests a “character string inputting means for inputting arbitrary character strings” as claimed in independent Claim 1 and supported in the Specification of the present application. Therefore, unlike the recording medium managing apparatus of independent Claim 1, Mikawa does not disclose or suggest a “character string inputting means for inputting arbitrary character strings” as claimed in independent Claim 1 and supported in the Specification of the present application. Ito and Osawa fail to cure the deficiencies of Mikawa. Moreover, it would

not have been obvious to one having ordinary skill in the art to have modified Ito in view of Osawa, and further in view of Mikawa to arrive at such a recording medium managing apparatus without reasonably being construed as impermissible hindsight reconstruction.

For at least these reasons, Claims 2, 4, 6, to 11, 18, and 19, which depend directly and indirectly from independent Claim 1, and Claims 14 and 15, which depend directly from independent Claim 13, are patentably distinguished over these references and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance, and such action is courteously solicited.

Respectfully submitted,

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